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Filed : July 14, 2003

#### **REMARKS**

Claim 8 is amended herein to remove allegedly unsupported subject matter. The amendments to the claims do not add new matter.

New Claim 23 is supported by the specification, for example, at page 12, last full paragraph. New Claim 23 does not add new matter.

Upon entry of the amendments, Claims 8, 10-12, 14, 15 and 19-23 are pending. Applicants respectfully request entry of the amendments and reconsideration of the application in view of the following remarks.

#### **Rejection Under 35 U.S.C. § 112, First Paragraph**

Claims 8 and 10-12 are rejected under 35 U.S.C. § 112, first paragraph as containing new matter because Claim 8 recites a negative limitation that is allegedly unsupported by the specification.

Without conceding the propriety of the rejection, Claim 8 is amended herein to remove the objected-to phrase. Accordingly, this rejection is moot.

#### **Rejection Under 35 U.S.C. § 103**

Claims 8, 10-12, 14, 15, 19 and 20 are rejected under 35 U.S.C. § 103 as being obvious over Sumi (US Pat No 6,582,789) in view of Masuda (U.S. Publication No. 2002/0064650). The Office Action states that Sumi teaches a protective film comprising an adhesive layer on one side of a substrate and an antistatic layer on the other side, and Masuda teaches an antistatic polymer containing pyrrolidinium rings. The Office Action also states that the recited transparency after heat treatment would be inherently present in the combination of the references.

Applicants submit that Claims 8, 10-12, 14, 15, 19 and 20 are non-obvious over the cited references because there is no reason to combine the teachings of the cited references in a manner to arrive at the claimed invention, and the claimed films possess superior properties that are unexpected over the teachings of the references.

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**There is No Reason to Combine Sumi and Masuda**

Masuda teaches that “the object of the present invention is to provide a film having *excellent light shielding* effect.” *Masuda* at paragraph [0009] (emphasis added). Thus, Masuda’s teachings are directed to films that are excellent in shielding light. In contrast, Sumi’s invention is directed to a surface protective film that “can be *highly transparent* and improve inspectability.” *Sumi* at Abstract (emphasis added). Thus, Sumi teaches the importance of high transparency in Sumi’s invention. One of skill in the art wishing to modify the teachings of Sumi’s teachings of a highly transparent film would not look to teachings that are directed to a film with excellent light shielding effect. In particular, there is no reason that one of ordinary skill would selectively choose a component of an “excellent light shielding” film for purposes of incorporating into a “highly transparent” film. As such, the combination of these references does not establish the claims as being *prima facie* obvious. *See M.P.E.P.* § 2143.01.IV.

Furthermore, the transparent surface protective film of the presently claimed invention contains pyrrolidinium rings in the main chain of a component polymer. As a result of the present of these pyrrolidinium rings, deposition of oligomer, even after one-hour heat treatment at 150°C, is prevented. *See Specification* at page 5, first full paragraph. This prevention of deposition of oligomer leads to the outstanding properties of the present invention, which facilitates visual inspection of the transparent conductive substrate, and prevents separation of the oligomers in the inspection process and manufacturing process. *Id.* These superior properties are not taught by either Sumi or Masuda, alone or combined. Accordingly, these superior properties are unexpected over the teachings of the cited references.

In view of the above, Applicants submit that the claims are non-obvious over the cited references, and respectfully request removal of this rejection of the claims.

**Rejection Under 35 U.S.C. §103**

Claims 8, 10-12, 14, 15 and 20-22 are rejected under 35 U.S.C. §103 as being obvious over JP 11-256116 in view of Masuda. The Office Action states that JP 11-256116 teaches a protective film comprising an adhesive layer on one side of a substrate and an antistatic layer on the other side, and Masuda teaches an antistatic polymer containing pyrrolidinium rings. The

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Office Action also states that the recited transparency after heat treatment would be inherently present in the combination of the references.

Applicants submit that Claims 8, 10-12, 14, 15 and 20-22 are non-obvious over the cited references because there is no reason to combine the teachings of the cited references in a manner to arrive at the claimed invention, and the claimed films possess superior properties that are unexpected over the teachings of the references.

**There is No Reason to Combine JP 11-256116 and Masuda**

Masuda teaches that “the object of the present invention is to provide a film having *excellent light shielding* effect.” *Masuda* at paragraph [0009] (emphasis added). Thus, Masuda’s teachings are directed to films that are excellent in shielding light. In contrast, JP 11-256116’s invention is directed to a surface protective film that is “*highly transparent*.” *JP 11-256116* at Abstract (emphasis added). Thus, JP 11-256116 teaches the importance of high transparency in JP 11-256116’s invention. One of skill in the art wishing to modify the teachings of JP 11-256116’s teachings of a highly transparent film would not look to teachings that are directed to a film with excellent light shielding effect. In particular, there is no reason that one of ordinary skill would selectively choose a component of an “excellent light shielding” film for purposes of incorporating into a “highly transparent” film. As such, the combination of these references does not establish the claims as being *prima facie* obvious. See *M.P.E.P.* § 2143.01.IV.

Furthermore, the transparent surface protective film of the presently claimed invention contains pyrrolidinium rings in the main chain of a component polymer. As a result of the present of these pyrrolidinium rings, deposition of oligomer, even after one-hour heat treatment at 150°C, is prevented. See *Specification* at page 5, first full paragraph. This prevention of deposition of oligomer leads to the outstanding properties of the present invention, which facilitates visual inspection of the transparent conductive substrate, and prevents separation of the oligomers in the inspection process and manufacturing process. *Id.* These superior properties are not taught by either JP 11-256116 or Masuda, alone or combined. Accordingly, these superior properties are unexpected over the teachings of the cited references.

In view of the above, Applicants submit that the claims are non-obvious over the cited references, and respectfully request removal of this rejection of the claims.

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**Rejection Under 35 U.S.C. §103**

Claims 19 is rejected under 35 U.S.C. §103 as being obvious over JP 11-256116 in view of Masuda and Sumi.

Claim 19 depends from Claim 8. As discussed above, there is no reason to combine either JP 11-256116 or Sumi with Masuda. Further, the film of Claim 8 possesses properties that are superior to and unexpected over the teachings of the cited references. For at least these reasons, Claim 19 also is non-obvious over the cited references.

**No Disclaimers or Disavowals**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

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**CONCLUSION**

In light of the Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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